



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,144	07/09/1999	KAZUNORI TAKAHASHI	21.1935	7639

21171 7590 05/22/2003

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

[REDACTED] EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
2615	

DATE MAILED: 05/22/2003

J

Please find below and/or attached an Office communication concerning this application or proceeding.

PD

Office Action Summary	Application No.	Applicant(s)	
	09/350,144	TAKAHASHI, KAZUNORI <i>(19)</i>	
	Examiner	Art Unit	
	Bob Chevalier	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,10-18 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,10-18 and 22-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 July 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 10, 12-16, 18, 22, 24-27, are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al.

Okamoto et al discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 1, 13, and 25, including the feature of detecting a copy guard signal included in an input video signal (See Okamoto et al's Figure 1, component 7), the feature of digitizing the input video signal (See Okamoto et al's Figure 1, component 6), the feature of processing circuit reducing screen information digitized by the video decoding circuit (See Okamoto et al's Figure 1, components 2-4, and column 3, lines 5-6, where it is disclosed the capability of compressing the inputted video signal; it is to be noted that reducing is an inherent feature of compressing since compression indicates the capability of squeezing, making more compact, or reducing the information), and the feature of storing the reduced screen information to a storage device in a case where the copy guard detecting circuit detects a copy guard signal as specified in the present claims 1, 13, and 25. (See Okamoto et al's Figure 1, component 14, and 1, and column 3, lines 9-22, where it is disclosed the capability of storing the reduced information in the case where the copy information indicates permissibility of copy).

With regard to claims 2, 14, and 26, the feature of the image processing circuit preventing from storing screen information digitized by the video decoding circuit to a storage device in the case where the copy guard detecting circuit detects the copy guard signal as specified thereof is present in Okamoto et al. (See Okamoto et al's Figure 1, components 2-4, which disclose the image processing circuit, and further, see Okamoto et al's column 3, lines 22-25, where it is disclosed prevention of recording operation when the copy guard signal indicates inhibition of copy).

With regard to claims 3, 15, and 27, the feature of storing to a storage device both screen information digitized and the fact of the detection of the copy guard signal as specified thereof is present in Okamoto et al. (See Okamoto et al's Figure 1, components 2-4, for the image processing circuit, and further, see Okamoto et al's column 3, lines 38-43, where it is disclosed the capability of recording reduced video signal together with copy information).

With regard to claims 6, 12, 18, and 24, the feature of adding copy guard signal to the output of screen information stored at the storage device, encoding and outputting a video signal as specified thereof is present in Okamoto et al. (See Okamoto et al's Figure 1, components 3-5, and further, see Okamoto et al's column 3, lines 60-67, where it is disclosed that copy information is added to the reproduced video signal).

With regard to claims 10, and 22, the feature of the image processing circuit reducing the digitized screen information in the case the digitized screen information is protected from copying and outputting the reduced and digitized information as specified thereof is present in Okamoto et al. (See Okamoto et al's Figure 1, component

Art Unit: 2615

2, 3, 4, and 6, and further see, Okamoto et al's column 2, lines 50-52, and column 3, lines 9-22, where it is disclosed the capability of compressing/reducing the digitized video signal and outputting the reduced video signal to the storage medium for recording purposes in the case where the copy information detected indicates permissible of recording operation).

With regard to claim 16, the feature of reducing the screen information stored at the storage device and outputting a video signal of the reduced screen information as specified thereof is present in Okamoto et al. (See Okamoto et al's Figure 1, components 11, and 13).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5, 11, 17, and 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al in view of the submitted prior art of Kitazawa Hiroaki (P.N. 09083920).

Okamoto et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 4-5, 11, 17, and 23, including the feature of storing to a storage device both screen information signal and copy guard signal and reproducing the stored signals from said storage device as specified in the

present claims 4-5, 11, 17, and 23. (See Okamoto et al's column 3, lines 38-43, and Okamoto et al's Figure 1, components).

Okamoto et al fails to specifically disclose the feature of preventing the video encoding circuit from outputting the video signal in the case where an output of screen information stored in the storage device is ordered, and in the case where the information is protected from copying as specified in the present claims 4-5, 11, 17, and 23.

The submitted prior art Kitazawa Hiroaki does disclose a reproducing apparatus which includes the capability of preventing a video encoding circuit from outputting an inputted video signal received from a storage device based on copy guard signal as specified in the present claims 4-5, 11, 17, and 23. (See Kitazawa's Figure 1 and the corresponding disclosure).

It would have been obvious to one skilled in the art to modify the Okamoto et al's recording/reproducing apparatus wherein the reproducing means/encoding means provided thereof (See Okamoto et al's Figure 1, components 2-4) would incorporate the capability of preventing the processing means from outputting the video signal in the case where an output of screen information stored in the storage device is ordered in the same conventional manner as shown by Kitazawa Hiroaki. The motivation being to prevent unauthorized viewing of the reproduced video signal as suggested by Kitazawa Hiroaki.

Response to Arguments

5. Applicant's arguments filed 3/17/03 have been fully considered but they are not persuasive.

Regarding the Applicant's argument in that the cited reference of Okamoto et al fails to specifically disclose the claimed feature of processing the screen information so as to reduce the image quality, Examiner disagrees. It is noted that such a feature of processing to reduce inputted screen information as specified in the claimed invention would be present in Okamoto et al. (See Okamoto et al's Figure 1, components 2-4, and column 3, lines 5-6, where it is disclosed the capability of compressing the inputted video signal; it is to be noted that reducing is an inherent feature of compressing since compression indicates the capability of squeezing, making more compact, or reducing the information).

Regarding the Applicant's argument in that the Okamoto et al fails to specifically disclose the claimed feature of the storage device storing the fact that the copy guard signal has been detected and/or reduced screen information, Examiner disagrees. It is noted that such a feature of storing the fact that the copy guard signal has been detected and/or reduced screen information argued by Applicant would be present in Okamoto et al. (See Okamoto et al's Figure 1, components 2-4, for the image processing circuit, and further, see Okamoto et al's column 3, lines 38-43, where it is disclosed the capability of recording reduced video signal together with copy information).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Art Unit: 2615

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Robert Chevalier
ROBERT CHEVALIER
PRIMARY EXAMINER

B. Chevalier
May 19, 2003